

Application No. 10/743,932
Response dated September 14, 2005
Attorney Docket No. G-0135B

1/FW/J
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

SUSAN M. ABERNATHY et al.

Serial No.: 10/743,932

Filed: December 23, 2003

For: FINISHED LUBRICANTS
COMPRISING LUBRICATING
BASE OIL WITH HIGH
MONOCYCLOPARAFFINS AND
LOW MULTICYCLOPARAFFINS

GROUP ART UNIT: 1764

EXAMINER: Walter D. Griffin

P. O. Box 6006
San Ramon, CA 94583-0806

RESPONSE and TERMINAL DISCLAIMER

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This communication is in response to the Final Office Action dated August 12, 2005. Please accept our terminal disclaimer in the above-identified patent application and charge our deposit account for all additional fees required.

I hereby certify that I have a reasonable basis for believing that this correspondence will be deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, P. O. Box 1450,
Alexandria, VA 22313-1450, on Sept. 14, 2005

Date of Deposit

Susan M. Abernathy
Name of Applicants, assignee, or Registered Rep.

Susan M. Abernathy Sept. 14, 2005
Signature Date

REMARKS

Original claims 1-30 remain in the case. Claims 31-33 have been previously cancelled.

The Provisional Obviousness Double Patenting Rejections of Claims 1-12 and 13-30

Claims 1-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/744870. The claims of 10/744870 do not include the step of blending the lubricating base oil with at least one lubricant additive, but the Office Action indicates that it would have been obvious to have modified the claims of 10/744870 by including the step of blending the lubricating base oils with at least one lubricant additive.

Claims 13-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/744389. The claims of 10/744389 do not include the step of blending the lubricating base oil with at least one lubricant additive, but the Office Action indicates that it would have been obvious to have modified the claims of 10/744389 by including the step of blending the lubricating base oils with at least one lubricant additive.

The provisional obviousness-type double patenting rejections are not final because the conflicting claims have not in fact been patented. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional refection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

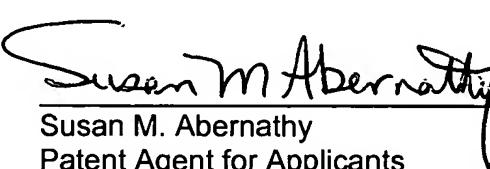
TERMINAL DISCLAIMER

Applicants herein file a terminal disclaimer for this application, Application No. 10/743,932. Copending Application Nos. 10/744870 and 10/744389 are commonly wholly owned and assigned to the same assignee as this application. The assignee is Chevron USA, Inc. Assignment documents for all three of these co-pending applications were received by the USPTO on May 17, 2004. The portion of the term being disclaimed in this application, 10/743,932, is the terminal portion extending beyond the earliest normal term of either 10/44870 or 10/744389 if and when they grant. The portion of the term being disclaimed is exclusive of a shortened patent term of either 10/44870 or 10/744389 resulting from abandonment, failure to pay maintenance fees, or a legal action rendering it invalid. Any patent granted on this application, 10/743,932, shall be enforceable only for and during such period that said patent is commonly owned with the applications which formed the basis for the rejections (10/744870 and 10/744389).

Conclusion

It is respectfully submitted that in view of the filed terminal disclaimer, all of the claims remaining in the case are now directed to patentable subject matter, and allowance in due course is respectfully solicited.

Respectfully submitted,



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SMAbernathy
September 14, 2005